IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Goddard, et al.
Appl. No.	:	10/063,728
Filed	:	May 8, 2002
For	:	A NUCLEIC ACID UNDEREXPRESSED IN STOMACH TUMOR
Examiner	:	Seharaseyon, J.
Group Art Unit	:	1647

PETITION UNDER 37 C.F.R. §1.181

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In accordance with 37 C.F.R §1.113(a), Applicants hereby Petition the Director under 37 C.F.R §1.181 to remove the finality of the outstanding Office Action issued in the above-identified patent application.

Statement of Facts

In the non-final Office Action dated February 7, 2005, Claims 1-10 and 12-20 were rejected under 35 U.S.C. §102(b) as being anticipated by Lal *et al.* (WO 00/00610A2) or Jacobs *et al.* (WO 00/09552).

On May 6, 2005, Applicants filed a Response traversing, *inter alia*, the anticipation rejections of the Office Action dated February 7, 2005, and contending that the instant application should be entitled to an earlier priority date.

In the presently outstanding final Office Action dated July 25, 2005, Claims 4-6, 12-14 and 16-31 were rejected under 35 U.S.C. §102(e) as being anticipated by Lal *et al.* (WO 00/00610A2) or Jacobs *et al.* (WO 00/09552). The final Office Action stated:

> Applicant has been accorded a priority date [of] 8/20/2000 for the polynucleotides only passed [sic] on the enabling disclosure [of] differential expression in PCT/US00/23328 filed August 24, 2000 (see above paragraph 9). Therefore the rejection of claims 1-20 under 35 U.S.C. 102(b) as being anticipated by of Lal et al. (WO200000610A2, Pub. Date 01/2000) or Jacobs et al. (WO200009552, Pub. Date 02/2000) is withdrawn because Applicants are entitled to a priority of 8/24/00, which makes the cited references 35 U.S.C. 102(e) art. Therefore, the pending claims 4-6, 12-14 and 16-31 are rejected under 35 U.S.C. 102(e) as being anticipated by of Lal et al. (WO200000610A2, Pub. Date 01/2000) or Jacobs et al. (WO200009552, Pub. Date 02/2000). (Final Office Action at pages 7-8)

Point to be Reviewed

Applicants submit that withdrawal of a rejection under 35 U.S.C. §102(b) and issuance for the first time of a rejection under 35 U.S.C. §102(e) constitutes a new ground for rejection. To hold otherwise would impede development of a clear issue between the Examiner and Applicants because Applicants have not had opportunity to address whether or not the art is properly prior art under 35 U.S.C. §102(e).

For a publication to qualify as prior art under 35 U.S.C. §102(b), it must be published more than one year prior to the priority date of the application. For a publication to qualify as prior art under 35 U.S.C. §102(e), it must, *inter alia*, be filed before the invention by the Applicant. Thus, a determination of whether or not a reference is properly prior art under 35 U.S.C. §102(b) is completely different from a determination of whether or not a reference is properly prior art under 35 U.S.C. §102(e). Moreover, a publication can be prior art under 35 U.S.C. §102(b) but not 35 U.S.C. §102(e) and vice versa.

In the present case, two references were applied under 35 U.S.C. §102(b) in the Office Action dated February 7, 2005. In a Response mailed May 6, 2005, Applicants fully responded to and successfully overcame the anticipation rejections in the Office Action dated February 7, 2005. Only after Applicants overcame the anticipation rejection under 35 U.S.C. §102(b) was the new statutory ground for rejection of the claims under 35 U.S.C. §102(e) applied. Because a determination of whether or not a reference is properly prior art under 35 U.S.C. §102(b) is completely different from such a determination under 35 U.S.C. §102(e), Applicants have not yet had an opportunity to address whether or not the art is properly prior art under 35 U.S.C. §102(e).

MPEP §706.07 states:

> Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection.
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> The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. However, it is to the interest of the applicants as a class as well as to that of the public that prosecution of an application be confined to as few actions as is consistent with a thorough consideration of its merits.
> (emphasis added)

The finality of the Office Action dated July 25, 2005 now hinders development of the issue of whether or not the cited references are properly prior art under the new statutory ground of 35 U.S.C. §102(e). Applicants submit that to hold that withdrawal of a rejection under 35 U.S.C. §102(b) and issuance for the first time of a rejection under 35 U.S.C. §102(e) does not constitute a new ground for rejection would stunt the development of a clear issue between Applicants and the Examiner.

Action Requested

In view of the above, Applicants respectfully request that the finality of the Office Action dated July 25, 2005 be removed.

CONCLUSION

Applicants submit that the finality of the Office Action dated July 25, 2005 is premature, and respectfully request the finality be removed.

No fee is deemed due under 37 C.F.R §1.181 as neither 37 C.F.R §1.181 nor 37 C.F.R §1.17 indicate that a fee is due in conjunction with a Petition under 37 C.F.R §1.181. However, in the event that a fee is due, please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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Dated: Sept. 23, 2005

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